

REMARKS

Claims 1-27 are outstanding. No claims have been canceled or added. Claims 1-22 have been withdrawn. Reconsideration and allowance of all the claims are respectfully requested.

Rejection under 35 U.S.C. § 103

Claims 23, 24, and 26 were rejected under 35 U.S.C. 103 (a) as being unpatentable over Ray, III et al. (US Patent No. 4,308,679) in view of Miller et al. (US Patent No. 5,127,743), and Kon et al. (JP 62-62736).

With regard to claims 23, 24 and 26, the Office Action states:

Ray, III et al discloses a laminated container structure. The laminated structure includes an inner wall of a paperboard or cardboard material and an outer wall of thin pliant material, which are considered to be flexible films, peelable panel, i.e. a strip, is formed in the outer wall material with slits or perforations completely through the outer layer, an adhesive layer between the outer and inner wall for bonding the outer wall material to the inner wall, and a coating a release agent or coating onto the rear surface of the strip to allow for easy peeling without injury to the inner wall material. (Col 4, lines 47-68) Ray, III et al is silent as to the feeding the first and second film into a laminator, extruding a molten plastic layer or adhesive layer between the first and second films, and slitting takes place within 1-24 inches from the pressing step. However, the feeding the first and second film into a laminator and extruding a molten plastic layer or adhesive layer between the first and second films is well known and conventional as shown for example by Miller et al. Miller et al. discloses a method of forming packaging material. The method includes providing a first and second web or film, feeding the films or webs into the laminator, extruding the adhesive between the films, and laminating the two films together. (Col 4, line 51 to Col 5, line 15 and Figure 6)

It would have been obvious to one of ordinary skill in the art at the time the invention was made to feed the first and second film into a laminator and extruding a molten plastic layer or adhesive layer between the first and second films as disclosed by Miller et al in the method of Ray, III et al to provide a method of forming a packaging material quickly and efficiently. (Col 2, lines 33-35) Ray, III et al as modified by Miller et al does not disclose the distance from slitting step to form a strip occurs within 1-24 inches from the pressing step. However, Kon et al discloses a method of forming laminated film, which provide a slitting step or slit wheel

just before lamination, (See English Abstract of JP 62-62736) and furthermore, determination of the specific distance between the slitting and pressing steps would have been well within the realm of routine experimentation to one of ordinary skill in the art at the time of the invention in view of the teaching of Kon et al that recognizes that the location, i.e. just before lamination, of the slitting step is ripe for optimization.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to optimize this parameter in order to provide accurate placement of the strip, improving the uniformity of the final products in the method of Ray, III et al. as modified by Miller et al.

Applicants respectfully traverse the rejection of Claims 23, 24, and 26 under 35 U.S.C. 103 (a). Applicants incorporate herein their arguments previously submitted in their Response to Office Action dated February 17, 2005. Applicants also present additional arguments in support of patentability of the claims being examined.

As previously discussed, a proper *prima facie* case of obviousness requires that the prior art reveal a reasonable expectation of success carrying out the proposed combination or modification. *In re Vaeck*, 947 F.2d 488, 493 (Fed. Cir. 1991). Both the suggestion and the reasonable expectation of success must be found in the prior art, not in the applicant's disclosure. *Id.* A proper *prima facie* case of obviousness cannot be established by combining the teachings of the prior art absent some teaching, incentive, or suggestion supporting the combination. *In re Napier*, 55 F.3d 610, 613, 34 U.S.P.Q.2d 1782, 1784 (Fed. Cir. 1995); *In re Bond*, 910 F.2d 831, 834, 15 U.S.P.Q.2d 1566, 1568 (Fed. Cir. 1990). A reference may be said to "teach away" from the claimed invention when a person of ordinary skill, upon reading the reference, would be discouraged from following the path set out in the reference, or would be led in a direction divergent from the path that was taken by the applicant. *In re Gurley*, 27 F.3d 551, 553, 31 U.S.P.Q.2D 1130, 1131 (Fed. Cir. 1995). Moreover, Section 706.02(j) of the MPEP states that "[t]o establish a *prima facie* case of obviousness . . . the prior art reference (or references when combined) must teach or suggest all the claim limitations."

The Examiner contends that one skilled in the art would be motivated to combine the lamination method disclosed by Miller with the panel of Ray III et al to provide a method of forming packaging material quickly and efficiently. Yet Miller, in several places, specifically

teaches away from use of a strip as part of an integral package film. The excerpts from the Miller patent below are illustrative:

- “Stickers on the outside of packages are easily peeled or removed. This renders the promotion useless.” (Miller, Col. 1, lns. 63-66).
- “A fairly simply yet widely used method involves the printing of the information directly on to the packaging itself. This has proven to be inefficient, however, because most packaging materials are not conducive to having printing placed upon them other than that relating to the standard label.” (Col. 1, lns. 30-35).
- “There have been many attempts at placing promotional pieces within package walls. However, they all have involved placing the piece within a pouch in the wall, which results in movement of the piece and loss in wall strength, or simply giving the piece to a wall surface.” (Col. 2, lns. 9-14).
- “[T]he amount of printing is limited to the size of the space available on the label.” (Col. 1, lns 45-47).

Further, Miller requires that for a consumer to “gain access to the piece, the package must be opened and destroyed.” (Col. 3, lns. 35-36). The present invention, on the other hand, permits the “strip 510’ to be used as a contest piece or prize notification, with its removal causing no harm to the packaging.” (Pat. App., p. 12, lns. 11-12). Further, claim 23 requires that the strip “can be separated from the rest of said flexible packaging film without injury to other layers of said packaging film.” Miller therefore fails to teach or suggest each and every claim limitation, and one skilled in the art would not be motivated to combine Miller with Ray, III to arrive at the presently claimed invention.

In fact, the Miller and Ray references each teach away from each other and are thus not properly combinable. Miller teaches that a package must be destroyed to access the promotional piece, whereas Ray teaches that a promotion panel be removable “without adversely affecting the integrity of the container structure or necessitating the use of special cutting instruments or tools.” See Ray, III et al., Abstract. The Ray reference actually emphasizes the undesirability of prior art containers that require destruction to access promotion, like Miller’s package. In reference to two particular prior art references, Ray states in column 2, lines 13-24, “each describe(s) containers providing for detachable coupons as integral components of the outer ply of a container wall structure. However . . . [these patents] require the destruction of the end of

the wall portion, thus creating the risk of inadvertently affecting the integrity of the container, or possibly producing an uneven or jagged container end edge after removal of the coupon.”

Section 2143.01 of the MPEP mandates that “[i]f the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious. *In re Ratti*, 270 F.2d 810, 123 USPQ 349 (CCPA 1959) (Patentee taught the device required rigidity for operation, whereas the claimed invention required resiliency).” Thus, one of ordinary skill in the art would not be motivated to make the changes proposed by the Examiner, as Miller teaches away from Applicant’s invention, and Miller and Ray each teach away from each other.

None of the cited references teach or suggest, as claimed by Applicants, that an upper layer of a laminate film be completely cut in two laterally-displaced locations such that a strip of the upper layer be completely detached on either side from the rest of the upper layer prior to entering the laminator. Nor do any of the cited references, alone or in combination, disclose the unique problem addressed by Applicants – that is, the problem of maintaining proper positioning of a completely-detached strip of a layer of laminate film as it passes into and through a laminator. Rather, the cited prior art references disclose only the concept of removable perforated patches of film, which remain secured to the rest of the film by the material left between perforations. For example, although the Kon references discusses making intermittent slits (perforations) in film prior to lamination, Kon fails to teach or suggest the making of continuous, complete cuts in the film to create a film strip that is entirely unattached on either side to the remainder of the film. Kon, in fact, teaches away from complete cutting, as evidenced by the purpose stated in its abstract: “To solve a trouble of air trapping without making holes in a cover film, without occurrence of cutting . . . by providing a slit-making device.” Thus, Applicants’ unique problem is never encountered, nor is it addressed, in any of the cited references. One of ordinary skill in the art would not be motivated to modify Applicants’ method for making a flexible packaging film to solve the problem confronted by Applicant’s invention.

Applicants disagree with Examiner’s contention that it would have been obvious to provide “a slitting step to form a strip within 1-24 inches from the pressing step.” On Page 11, lines 13-19 of the filed patent application, applicants state, “In order to reliably cut through the material without creating problems, two considerations are important: 1) the slitters must be oriented so that the plane of the slitter is perpendicular to the plane of the material being slit,

with the cutting edge facing the oncoming material squarely, and 2) the slitters must be placed within one to twenty-four (1-24) inches of the laminator nip roller. If these precautions are not observed, the cut film can move unnecessarily, causing overlapping with adjacent pieces or else allowing open spaces between adjacent pieces of film.” Applicants therefore assert that Examiner’s unsupported contention that “the slitting and laminating steps would perform equally well at any distance” is in error. Moreover, as explained above, Applicants’ unique problem – of properly positioning a strip of film that is completely cut and unattached on either side to the rest of the film – is never contemplated in the prior art because the prior art methods involve incomplete cutting/slitting. The perforated panels of the prior art do not require special processing to ensure proper positioning in a laminating machine. Applicants therefore respectfully request that Examiner withdraw the rejection of claims 23, 24, and 26.

Claims 25 and 27 were rejected under 35 U.S.C. 103 (a) as being unpatentable over Ray, III et al. (US Patent No. 4,308,679) in view of Miller et al. (US Patent No. 5,127,743), and Kon et al. (JP 62-62736) and as applied to claim 23 above, and further in view of Walker (US Patent No. 3,879,246).

With regard to claims 25 and 27, the Office Action states:

Ray, III et al as modified above is silent as to applying the adhesive to first web, outer wall material, and the release coating on the second web, inner wall material. However, applying adhesive to the strip is well known and conventional as shown for example by Walker. Walker discloses a method for laminating a foil strip. The method includes applying hot melt adhesive to the foil strip (Col 7, lines 4-13) prior to slitting into strips and would require the release coating to be placed on the second web to allow removal, which is considered to be equivalent.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide adhesive on the first web or attachment strip and release coating on the second web or vice versa as disclosed by Walker in the method of Ray, III et al as modified by the combination of references because they are equivalent.

For the same reasons as discussed above regarding the Miller, Ray, and Kon references, Applicants respectfully request that Examiner withdraw the rejection of Claims 25 and 26. As

explained above, Miller and Kon clearly teach away from the present invention, and Miller and Ray each teach away from each other. Furthermore, none of the cited references addresses Applicants' unique problem of (and solution for) maintaining proper positioning of a strip of film passing through a laminator wherein the strip of film is completely cut and detached on either side from the rest of the film. Thus, one skilled in the art would not be motivated by the Miller, Ray, and/or Kon references to arrive at the claimed invention.

"Presuming *arguendo* that the references show the elements or concepts urged by the examiner, the examiner has presented no line of reasoning, and we know of none, as to why the artisan viewing only the collective teachings of the references would have found it obvious to selectively pick and choose various elements and/or concepts from the several references relied upon to arrive at the claimed invention." *Ex Parte Clapp*, 227 USPQ 972 (PTO Bd App. 1985); *In Re Horn*, 203 USPQ 969 (CCPA 1979). Ray III et al discloses pliant material adhered to a rigid material. As shown by Figure 1 of the Ray III patent, the pliant material has a panel defined on one side by a continuous cut 38, on two sides by perforated cuts 24 and on one side by a series of overlapping cuts 32. As shown by Figure 1 of the Walker reference, Walker discloses a plurality of rectangular flexible strips 51 applied to a web of film. The strips 51 require both longitudinal and transverse cutting (see numerals 272 and 281 on Figure 20 of Walker reference) prior to lamination. Miller discloses a pre-cut promotional piece requiring an application of a first quantity of hot liquid polyethylene followed by a second quantity of hot liquid polyethylene. (See Col. 3, lns. 1-9). The pre-cut promotional piece is then placed between two layers of film. Moreover, to access the promotional piece, Miller teaches that its packaging should be destroyed/opened, whereas Ray teaches that access should occur without damaging the packaging. One skilled the art would therefore not be motivated to combine the teachings of the Miller and Ray references. The cited references, taken together, fail to suggest or teach the claimed invention that provides a method for making a flexible packaging film that permits a strip to be separated from the rest of the film without injury to the other layers of packaging film. Examiner's conclusory statement that the combination of these references would be obvious to one skilled in the art because they are 'equivalent' is vague and fails to provide the necessary suggestion or motivation to combine the art in the stated manner.

The Examiner's failure to provide the necessary suggestion or motivation for the combination of Ray III, Walker, Miller, and Kon, other than the aforementioned assertion, creates a presumption that the combination was selected by Examiner to support the obviousness rejection

based on improper hindsight. A determination of the desirability of combining prior art references must be made without the benefit of hindsight afforded by the Applicant's disclosure. *In re Paulsen*, 30 F.3d 1475, 1482, 31 U.S.P.Q. 1671, 1676 (Fed. Cir. 1994). Thus, even if the references could be combined in the manner suggested by the Examiner, the modification or combination is not obvious, because the references fail to suggest or teach the desirability of the modification. Thus, the claimed invention may only be reached using the presently claimed invention as a template to piece together and modify the teachings of the cited art to teach the presently claimed invention. Such reliance is an impermissible use of hindsight with the benefit of Applicant's disclosure. Thus, it is respectfully submitted that Examiner has not established a prima facie case of obviousness, and the rejection of Claims 25 and 27 should be withdrawn.

In view of the above, Applicants respectfully submit that the rejection of claims 23-27 is overcome. Accordingly, it is respectfully requested that Examiner withdraw all Section 103 rejections.

EXAMINER'S RESPONSE TO ARGUMENTS

Claims 23-27 were previously rejected under 35 U.S.C. 103 (a) as being unpatentable over Ray, III et al. (US Patent No. 4,308,679) in view of Miller et al. (US Patent No. 5,127,743), and Kon et al. (JP 62-62736) and as applied to claim 23 above, and further in view of Walker (US Patent No. 3,879,246).

In response to Applicants' arguments filed April 11, 2005, Examiner states (with emphasis added by Applicants):

Miller teaches the strip is attached to either the inner or exterior package wall (Col 6, lines 1-15) and provide a pull tab and perforation combination to allow easy removing. (Col 5, lines 12-15) The combination of Ray, II et al. and Miller discloses the instant invention.

Applicants' arguments with respect to claims 23-27 have been considered but are moot in view of the new ground(s) of rejection.

For the same reasons as discussed above regarding the Miller and Ray references, Applicants respectfully request that Examiner withdraw the rejection of Claims 25 and 26. Applicants also submit that their arguments contained herein are not rendered moot by Examiner's new ground for rejection.

None of the cited references teach or suggest, as claimed by Applicants, that an upper layer of a laminate film be completely cut in two laterally-displaced locations such that a strip of the upper layer be completely detached on either side from the rest of the upper layer prior to entering the laminator. Nor do any of the cited references, alone or in combination, disclose the unique problem addressed by Applicants – that is, the problem of maintaining proper positioning of a completely-detached strip of a layer of laminate film as it passes into and through a laminator. Rather, the cited prior art references disclose only the concept of removable perforated patches of film, which remain secured to the rest of the film by the material left between perforations. For example, while Miller may disclose a pull-tab and perforated patch of film, it does not disclose or suggest a method involving cutting from a film layer a strip that is completely unattached on either side to the originating film. Nor does Miller disclose the unique problem of maintaining proper positioning of such a detached strip as it passes through a laminator. Likewise, although the Kon references discusses making intermittent slits (perforations) in film prior to lamination, Kon fails to teach or suggest the making of continuous, complete cuts in the film to create a film strip that is entirely unattached on either side to the remainder of the film. Kon, in fact, teaches away from complete cutting, as evidenced by the purpose stated in its abstract: “To solve a trouble of air trapping without making holes in a cover film, without occurrence of cutting . . . by providing a slit-making device.” Thus, Applicants’ unique problem is never encountered, nor is it addressed, in any of the cited references. One of ordinary skill in the art would not be motivated to modify Applicants’ method for making a flexible packaging film to solve the problem confronted by Applicant’s invention.

Furthermore, the Miller and Ray references each teach away from each other and are thus not properly combinable. Miller teaches that a package must be destroyed to access the promotional piece, whereas Ray teaches that a promotion panel be removable “without adversely affecting the integrity of the container structure or necessitating the use of special cutting instruments or tools.” See Ray, III et al., Abstract. The Ray reference actually emphasizes the undesirability of prior art containers that require destruction to access promotion, like Miller’s package. In reference to two particular prior art references, Ray states in column 2, lines 13-24, “each describe(s) containers providing for detachable coupons as integral components of the outer ply of a container wall structure. However . . . [these patents] require the destruction of the end of the wall portion, thus creating the risk of inadvertently affecting the integrity of the container, or possibly producing an uneven or jagged container end edge after removal of the

coupon.” Section 2143.01 of the MPEP mandates that “[i]f the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims prima facie obvious. *In re Ratti*, 270 F.2d 810, 123 USPQ 349 (CCPA 1959) (Patentee taught the device required rigidity for operation, whereas the claimed invention required resiliency).” Thus, one of ordinary skill in the art would not be motivated to make the changes proposed by the Examiner, as Miller teaches away from Applicant’s invention, and Miller and Ray each teach away from each other.

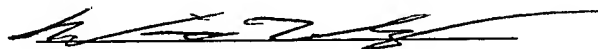
CONCLUSION

In light of the amendments and the arguments made by Applicants above, Applicants submit that all existing claims are now in a condition for allowance. Applicants respectfully request that Examiner withdraw all restrictions and rejections with regard to the above-referenced claims in reliance on one or more of the grounds submitted by Applicants.

If there are any outstanding issues that the Examiner feels may be resolved by way of telephone conference, the Examiner is invited to call Colin Cahoon or William Wang at the below-listed telephone number if in the opinion of the examiner such a telephone conference would expedite or aid the prosecution and examination of this application.

The Commissioner is hereby authorized to charge any payments that may be due or credit any overpayments to CARSTENS & CAHOON, L.L.P. Deposit Account 50-0392.

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